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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re James M. Medlock

Serial No. 78176264

Timothy B. McCormack of Barnard & McCormack for James M. Medlock.

Susan C. Hayash, Trademark Examining Attorney, Law Office 110 (Chris A. F. Pedersen, Managing Attorney).

Before Seeherman, Chapman and Zervas, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

James M. Medlock filed, on October 19, 2002, an application to register on the Principal Register the mark ROAD ARMOR for "aftermarket fitted vehicle bumpers and hard tops" in International Class 12. The application is based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a), and April 15, 1995 is claimed in the application as applicant's date of first use of the mark

anywhere and June 1, 1996 is claimed in the application as applicant's date of first use of the mark in commerce.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of the previously registered mark OFFROAD ARMOR for "land vehicle accessory, namely, a protective cover made of magnetic sheeting that covers and protects the paint of the vehicle exterior body panels while the vehicle is in operation or being towed" in International Class 12.¹

Applicant has appealed the final refusal. Both applicant and the examining attorney have filed briefs. Applicant did not request an oral hearing.

Our determination of the examining attorney's refusal to register the mark under Section 2(d) of the Trademark Act is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between

¹ Registration No. 2243657, issued May 4, 1999. Section 8 affidavit accepted.

the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We turn first to the marks. Both marks are constructed in the same manner - consisting of two words, ROAD ARMOR and OFFROAD ARMOR; ROAD and ARMOR are in the same order in both marks; and ROAD and ARMOR are both adjacent to each other, separated by a space. Further, applicant's mark does not include any additional wording, which possibly could serve to distance applicant's mark from registrant's mark. Applicant simply did not include the term OFF in its mark.

Applicant, in arguing that the marks are "substantially different," maintains that each mark has a dominant portion; that the dominant portion is "the first element to be articulated by the consumer"; that the dominant portion of OFFROAD ARMOR is OFFROAD and the dominant portion of ROAD ARMOR is ROAD; and that "there is no visual similarity, no phonic similarity and no similarity in meaning between the dominate [sic] portions of the two marks."

A term is not necessarily the dominant term in a mark simply because the term appears first in a mark. Other

considerations are involved in determining whether a mark has a dominant portion, such as the distinctiveness of other terms in the mark. See 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 19:72 (4th ed. 2005) ("a descriptive part of a composite is regarded as a weaker and less dominant portion which makes a lesser impact on the ordinary customer.")

Applicant contends that "the armor portion of the mark actually describes a function of the product, namely, 'magnetic sheeting that covers and protects the paint,'" and that "[i]t would be improper to give any great weight to a purely descriptive term such as 'armor.'" Applicant has not provided, however, any evidence of the asserted descriptiveness of "armor" in the relevant automotive field. ARMOR has not been disclaimed in either the cited registration or in the involved application. Additionally, "armor" as defined in *The American Heritage Dictionary of the English Language* (2003), does not include a definition in the automotive context.² The nearest relevant definition

² The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). In this case, we take judicial notice of the following definition of "armor" in *The American Heritage Dictionary of the English Language* (2003):

- A defensive covering, as of metal, wood, or leather, worn to protect the body against weapons. (footnote continued)

of "armor" would be a "protective covering," but in the context of military vehicles such as tanks. Simply put, applicant has not persuaded us that ARMOR, in the context of registrant's goods, is descriptive thereof.

We add that there is no evidence in the record that ARMOR is a weak term in the automotive area. Further, there is no reason to believe that the terms ROAD or OFFROAD would have more of an impact on the buyer in perceiving the marks.

We therefore give ROAD, OFFROAD and ARMOR equal weight in comparing the marks as a whole and find that the marks are highly similar in sound, appearance and commercial impression.

Applicant argues that his mark has a different meaning than that of the registered mark:

"[O]ff-road" is the opposite of "on-road." The first means going where there is [sic] no roads. The second means normal driving.

Although the terms "road" and "off-road" have slightly different meanings, nonetheless, both relate to the

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- A tough, protective covering, such as the bony scales covering certain animals or the metallic plates on tanks or warships.
 - A safeguard or protection: faith, the missionary's armor.
 - - a. The combat arm that deploys armored vehicles, such as tanks.
 - b. The armored vehicles of an army.

location a vehicle is driven. This slight difference is not so significant as to sufficiently distinguish the marks in terms of meaning, or of appearance, sound or commercial impression. In saying this, we are mindful that the comparison of the marks is not made on a side-by-side basis and that recall of purchasers is often hazy and imperfect.

We next consider the similarity or dissimilarity of registrant's and applicant's goods, the relevant trade channels and the purchasers of such goods. Applicant's "aftermarket fitted vehicle bumpers and hard tops" serve to protect the vehicle from damage.³ Similarly, registrant's magnetic sheeting serves to protect the paint of the vehicle "while the vehicle is in operation or being towed." Thus, the goods have an identical purpose, i.e., protection of the vehicle. Further, because nothing in the identification of goods restricts the goods to particular types of vehicles, the goods could be used with all vehicles.

Applicant states that his goods "are very different" from registrant's goods; that his goods "are very

³ By definition, a "bumper" functions to protect. See *American Heritage Dictionary of the English Language, Fourth Edition* (2003) definition of "bumper" (of which we take judicial notice): "A usually metal or rubber bar attached to either end of a motor vehicle, such as a truck or car, to absorb impact in a collision."

specialized and designed to actually change the look of the automobile and make it appear to be more of a custom automobile"; and that in contrast, registrant's goods are "very specific in that they are sold to off-road enthusiasts to protect the paint on their trucks."

Applicant's arguments are not well taken in light of registrant's and applicant's identifications of goods, as well as applicant's substitute specimens. First, registrant's identification of goods does not state that registrant's goods are sold only to off-road enthusiasts - the identification states that registrant's exterior body panels serve to protect the exterior of the vehicle "while the vehicle is in operation or being towed." Thus, we do not agree that only off-road enthusiasts are registrant's customers. Second, registrant's identification of goods does not limit the use of the goods to "off-road" only. Because restrictions may not be read into an identification of goods, we must assume that the goods are used in all normal uses, *Kangol Ltd. v. KangaROOS U.S.A., Inc.* 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992), including "while the vehicle is in operation," i.e., on highways, primary roads and secondary roads. Third, applicant's substitute specimens depict trucks, off-road, on rugged terrain. Thus, applicant's own specimens show that its goods can be

used on trucks in an off-road environment, the very manner in which applicant claims the registrant's goods would be used.

We find that the identified goods are related.⁴

Additionally, neither the identification of goods in applicant's application nor the identification of goods in the cited registration includes any restrictions as to purchasers or trade channels. Hence, we must presume that both registrant's and applicant's goods are suitable for sale to all potential purchasers of such goods and will travel in all channels of trade that would be normal for such goods. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981). It is our view that the same classes of purchasers will likely purchase both registrant's and applicant's goods. The "very particular car and truck buffs" - as applicant identifies his purchasers - who purchase applicant's goods "as specialized automobile enhancements" would also be likely to purchase registrant's magnetic sheeting to protect the car's and truck's exterior "while the vehicle is in operation or being towed," either by a towing service

⁴ In reaching this conclusion, we have not relied on the ten third-party registrations made of record by the examining attorney. The goods identified in these registrations are not sufficiently related to registrant's goods, or are not specific enough to allow us to conclude that they actually refer to the same goods involved in this application and the cited registration.

or by themselves.⁵ Certainly, car and truck enthusiasts who take pride in the appearance of their cars and trucks, including the paint on their cars and trucks, would be purchasers of both applicant's and registrant's goods. This is evident from the substitute specimens filed by applicant, which shows a truck with oversized wheels and large bumpers, navigating a hill, *off-road*. Thus, we find that registrant's and applicant's related products would likely be purchased by the same or overlapping classes of purchasers through the same or overlapping channels of trade.

Applicant has also argued that "applicant's services [sic] are sold as specialized automobile enhancements to very particular car and truck buffs, the purchasers take great care before making their purchases and are not likely [to] be confused." However, even if care is exercised in making such purchases, this care is outweighed by the similarities between the marks and the goods sold thereunder. Quite simply, even if the purchasers are careful enough to note the differences in the marks, they

⁵ Applicant suggests that the OFFROAD ARMOR goods "are sold to very particular and very different off-road enthusiasts"; and that the registrant's goods are "used to protect a vehicle during 'off-road' sessions." However, registrant's identification of goods is not so restricted; it provides that the goods are used "while the vehicle is in operation [off-road or otherwise] or being towed."

are likely to assume that the differences relate to different uses of the goods, rather than to differences in the source of the goods.

Applicant next argues that there has been no actual confusion between applicant's mark and registrant's mark. The fact that an applicant in an ex parte case is unaware of any instances of actual confusion is generally entitled to little probative weight in the likelihood of confusion analysis, inasmuch as the Board in such cases generally has no way to know whether the registrant likewise is unaware of any instances of actual confusion, nor is it usually possible to determine that there has been any significant opportunity for actual confusion to have occurred. See, *Majestic Distilling, supra* at 1317; and *In re Jeep Corporation*, 222 USPQ 333 (TTAB 1984).

Also, applicant maintains that "applicant's use of the mark was first in time"; and that "any and all doubts as to the likelihood of confusion should be drawn in applicant's favor because they are the first user of the mark." However, there are no doubts as to the likelihood of confusion in this case. Further, applicant mistakes the test. In those ex parte cases which discuss the resolution of doubt, doubt is resolved in favor of the registrant, which may or may not be the prior user of the mark. Here,

applicant is obviously not the registrant, and therefore doubt would not be resolved in its favor. Moreover, to whatever extent applicant is asserting that it has priority of use, priority of use is not an issue in an ex parte appeal. See *In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278 (CCPA 1971); and *In re Wilson*, 57 USPQ2d 1863 (TTAB 2001).

Accordingly, upon review of all of the relevant *du Pont* factors, and particularly the similarities of the marks and the related nature of the identified goods, and the commonality of purchasers and trade channels, we find that applicant's mark ROAD ARMOR for "aftermarket fitted vehicle bumpers and hard tops" is likely to cause confusion with the registered mark OFFROAD ARMOR for "land vehicle accessory, namely, a protective cover made of magnetic sheeting that covers and protects the paint of the vehicle exterior body panels while the vehicle is in operation or being towed."

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed.